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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 253

MOHASCO INDUSTRIES, INC.,
Petitioner,

vs.

E. T. BARWICK MILLS, INC.,

AND

BARWICK CARPET MILLS, INC.,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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Petitioner, Mohasco Industries, Inc., prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit entered in the above case on January 22, 1965.

Opinions Below

The opinion of the Court of Appeals is reported at 340 F. 2d 319 and affirms a decision of the United States District Court for the Northern District of Georgia reported at 221 F. Supp. 191. Copies of both opinions are printed in Appendix B hereto.

Jurisdiction

The judgment of the Court of Appeals was entered on January 22, 1965, and an order denying a timely petition for rehearing was entered on March 18, 1965. Copies of the judgment and order are printed in Appendix B hereto.

The jurisdiction of this Court is invoked under 28 U. S. C. Sec. 1254 (1). The basis for jurisdiction in the District Court was 28 U. S. C. Sec. 1338(a).

Questions Presented

In this patent infringement action, the sole defenses were that the two patents in suit are invalid under 35 U. S. C. Sec. 103 and were not infringed. On August 30, 1963, the District Court filed an opinion (App. B pp. 4a-16a), which, except for minor editorial changes and omissions, was a verbatim copy of the first twenty-four pages and a part of page 25 of a pre-trial memorandum (I 136-160)[1] filed by respondents more than four months before the trial started. The Court also adopted, with inconsequential changes, findings of fact (App. B pp. 16a-31a) prepared by respondents and adopted, without change, conclusions of law (App. B p. 31a) prepared by respondents. The conclusions were that both patents are invalid because they define an "obvious use" of a known "principle" and that neither patent was infringed.

Of the three principal findings on which the conclusion of invalidity is based, Finding No. 12 (App. B p. 23a) ignores major differences between the patented devices and the prior art and sets forth only the difference between simplified models illustrative of a single feature of the patented devices and the prior art. The second and third

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[1] The references are to pages in volumes I to V, incl., of the printed record prepared for the Court of Appeals. Nine copies of the record have been filed with this petition.

of the principal findings, No. 10 (App. B p. 21a) and No. 15 (App. B p. 24a), are in direct conflict with the record. The single finding, No. 25 (App. B p. 30a), relating to infringement is contrary to the record.

In a *Per Curiam* opinion (App. B p. 34a) containing no discussion of the issues and no clue to the manner of arriving at its decision, the Court of Appeals said merely that it was "in agreement with the result reached by the trial court" and, in an order denying a petition for rehearing (App. B p. 36a), the Court said that it considered "the opinion of the District Court sufficiently informative, and a correct disposition of the issues presented".

The questions presented are:

1. Whether, in this case, the Court of Appeals "has so far departed from the accepted and usual course of judicial proceedings" or has "so far sanctioned such a departure" by the trial court "as to call for an exercise of this court's power of supervision" (Rule 19(1)(b)); and

2. Whether the District Court and the Court of Appeals properly applied Sec. 103 and the applicable rules of law in deciding the issues of validity and infringement.

Constitutional Provision, Statutes, and Rules Involved

This case involves Article I, Section 8, clause 8, of the Constitution, Sections 103 and 112 of Title 35 of the United States Code, Rule 52(a) of the Federal Rules of Civil Procedure, and Rule 19(1)(b) of this Court, all of which are printed in Appendix A hereto.

Statement of the Facts

Petitioner has been a manufacturer of woven carpets for many years and has made tufted carpets since early 1953 (I 234-6; 239). Respondents are a manufacturing and a

selling company of common ownership which began to make and sell tufted carpets in the fall of 1950 (II 765).

The patents in suit cover attachments for use with tufted carpet machines to make possible the production of carpets having a pile of high and low loops of yarn arranged in accordance with a predetermined pattern.

Tufted carpets are made on special sewing machines equipped with a row of vertical needles at a close spacing such that a machine for making carpet 15 feet wide[2] has over a thousand needles (III 1307). Near its pointed lower end, each needle has an eye threaded with a pile yarn and, in the operation of the machine, the needles are reciprocated vertically at a high speed[3] and, on each down stroke, the needles pass loops of pile yarn through a backing sheet, usually of burlap. The machine is provided with a row of hooks, one for each needle, mounted below the sheet and, near the bottom of the down stroke of the needles, the hooks swing to enter the loops of pile yarn carried by the needles. As the needles rise, the hooks retain the loops until the needles are clear of the sheet, whereupon the sheet moves forward, the hooks release the loops, and the needles descend again. The operations are repeated until the backing sheet has been fully tufted and has a pile made of loops of pile yarn in rows extending both across and lengthwise of the sheet. The pile yarns are fed to the needles by a feed roll and the height of the loops is determined by the rate of feed of the yarns (II 534).

Prior to the inventions of the patents in suit, Boyles applied for patent 2,876,441 (V 1915) on a method of making a tufted fabric with a pile formed of high and low loops arranged according to a pattern. The Boyles method involves feeding pile yarns to tufting needles in varying

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[2] The 15-foot tufting machine is the one most widely used.

[3] Tufting machine speeds of 600 stitches per minute are common (III 1308).

lengths and is described in the patent as practiced by an attachment having three feed rolls feeding separate groups of pile yarns and capable of being operated independently of one another under the control of a pattern mechanism at a high speed or a low speed. The speed of a roll determines whether the yarns fed thereby will form high or low loops and the pattern mechanism controls the speed of the individual rolls and produces an arrangement of the loops according to the pattern.[4]

Pattern attachments with multiple feed rolls for practicing the Boyles method first appeared on the market in 1952 and 6-roll attachments were in common use before the inventions of the patent in suit (II 838-9). The trade soon found that feeding the yarns in large groups[5] by a 6-roll attachment restricts the patterns made to simple geometric forms and prevents the production of patterns with floral effects (II 890-1) common in Wilton carpets for many years (II 941). The tufters wanted to produce "any kind of pattern we wanted to and any practical heights of pile" (II 811) and this required independent control of individual pile yarns being fed to the tufting machine needles (II 811).[6] The problem was to devise an attachment for a tufting machine which would effect such single yarn control. Obviously, a roll attachment would be impractical for the purpose since it would be necessary to provide a roll for each yarn and pattern mechanism for controlling the speed of the individual rolls.

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[4] The District Court referred to the "Boyles' controlled-feed principle" in Finding 14 (App. B p. 24a). Presumably the Court had in mind the Boyles method above described.

[5] Each roll of a 6-roll attachment for a 15 ft. tufting machine feeds more than 160 yarns and, transversely of the carpet, the loops of all yarns fed by the same roll are alike, either high or low.

[6] Such control is sometimes referred to as "single needle control" (II 577) and "single end control". In the carpet trade, an "end" is a pile yarn.

The slat attachments of the patents in suit, Odenweller, 2,853,032 (IV 1413) and Crawford 2,853,033 (IV 1418), both issued to petitioner on September 23, 1958, were the first practical tufting machine pattern attachments capable of providing single yarn control. Respondents do not deny that the patented attachments were the first solution of the problem.

The Odenweller '032 patent discloses an attachment which includes a roll or drum having a set of lengthwise teeth or slats and a smaller diameter roll or pinion having a set of slats meshing with those on the drum. The drum and pinion rotate on fixed centers and are driven at a uniform rate and the pile yarns pass between and are fed to the tufting machine needles by the meshing slats. The slats are long enough to feed a large number of yarns and the yarns are guided to lie side by side as they pass between the drum and pinion. The lengths of the yarns fed at any given rate of rotation of the drum and pinion depend on the height of the slats and the degree to which they are meshed. The pinion slats are of the same height from end to end but the slats on the drum have notches of varying depths in accordance with a predetermined pattern. The notching of the drum slats has the effect of varying the degree of mesh of the slats engaging respective individual yarns, so that, although the drum and pinion rotate at a uniform rate, each individual yarn may be fed at predetermined varying rates, depending on the depth of the particular notches in which it has been received, in order to produce the desired pattern of loops in the carpet.

The Odenweller '032 patent covers broadly a new combination of elements, of which the drum with the slats notched in accordance with a pattern is new. The combination produces a new result, namely, independent control of individual pile yarns being fed.

Odenweller conceived his invention in the late fall of 1953 and completed it by filing his patent application on April 1, 1954.

The Crawford '033 patent covers an improved form of the Odenweller attachment, in which each set of slats is mounted on endless chains and the chains pass between fixed parallel guides, so that a number of slats of each set held in unchanging mesh by the guides grip and feed the yarns with no chance of slippage. The slats of one set are notched in accordance with a pattern so that, although the slats and chains travel at a uniform rate, individual yarns are fed at varying rates as required by the pattern.

Crawford's conception of the invention occurred in late 1953 and he completed the invention by filing his patent application on July 22, 1954.

The patents are of great commercial importance and the slat attachment has become the "mass production" attachment of the industry (III 1195; 1225). The importance of the patents can be judged from the fact that, at the time of the trial, about 3½ years after the first license was granted, petitioner, its licensees, and respondents had in use nearly 90 slat attachments of the Crawford type, of which 17 attachments were in use by respondents. In the period mentioned, the licensees paid royalties of about $528,000 (IV 1831; V 1861). One of the licensees said that the slat attachment is "a significant milepost in the development of an industry that has exceeded all expectations" and is "the finest addition that has ever been made to it" (IV 1697).

For years prior to the patents in suit, circular knitting machines had been provided with furnishing wheels for supplying yarn to the knitting needles in accordance with the demand of the machine so that the machine would produce uniform stitches (III 1327-9). Such furnishing wheels are commonly a pair of meshing gears feeding a single yarn between them and one gear rotates on a fixed center and the other is movable relative to the first to adjust the degree of mesh of the teeth and thus vary the rate of yarn feed. In some furnishing wheel devices, the

movable gear is moved by hand to adjust the mesh of the teeth and the rate of yarn feed, while, in others, the movable gear is moved automatically by changes in tension in the yarn with an increase in tension producing an increase in mesh and a faster feed and vice versa. Hand operated and automatic furnishing wheels are disclosed, respectively, in the patents to Howie 1,581,093 (IV 1570) and Lawson 2,247,244 (IV 1593) cited in the applications for the patents in suit. Respondents cited the patents to Sawyer 2,432,685 (V 1995) and Lawson 2,247,245 (V 2003) which disclose automatic furnishing wheels. The furnishing wheel devices of the Sawyer and the two Lawson patents are closely similar (III 1334, 1338). Furnishing wheels do not grip the yarn tightly and no one has ever used a pattern device for controlling the action of furnishing wheels (III 1331). Since automatic furnishing wheels respond to changes in the tension of the yarn being fed and such changes are accidental and differ with different yarns, a pair of wheels can feed only one yarn (III 1348).[7] The testimony on these points is undisputed.

The trial court based its conclusion of invalidity in part on Finding No. 12 (App. B p. 23a), in which the court compared models (V 1985, 1987) illustrative of the Odenweller and Crawford forms of the slat attachment but for feeding a single yarn only, with a pair of furnishing wheels. The Court found that the only difference between the one-yarn models and the furnishing wheels was that, in the models, varying intermesh of the slats is obtained by varying the height of the slats, whereas, in furnishing wheels, varying intermesh of the teeth is obtained by varying the spacing between the wheel centers. The Court was either unaware of or forgot major differences between the slat attachment and furnishing wheels, as follows.

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[7] The District Court referred to the "intermeshing principle of furnishing wheels" in Finding 14 (App. B p. 24a). Presumably the Court had in mind that the rate of feed of a yarn by intermeshing teeth varies directly with the degree of mesh.

A slat attachment can feed an unlimited number of yarns independently of one another at varying rates and thus can feed the more than a thousand yarns used in a 15-foot tufting machine. The only way to feed a thousand and more yarns independently of one another by furnishing wheels would be to use more than a thousand pairs of wheels and a pattern mechanism not so far invented for controlling the action of the wheels. A slat attachment feeds the yarns as determined by the pattern mechanism built into the slats[8] to produce loops of non-uniform height required by the pattern, whereas furnishing wheels are used in order that a knitting machine may produce uniform stitches and the wheels respond to forces outside the attachment, namely, variations in yarn tension, to overcome the effect of such tension variations. The slat attachment feeds the yarns positively (I 393-4; II 931) whereas furnishing wheels feed the yarns with slippage (III 1331).

The Court's Conclusion 4 (App. B p. 31a) that the slat attachment involved only "an obvious use of the intermeshing principle of yarn-furnishing wheels" is thus based on a finding which ignores major differences between "the subject matter" and the prior art, as prescribed in Sec. 103.

The second principal finding, No. 10 (App. B p. 21a), on which the conclusion of invalidity was based, was that Parker and Short, employees of Callaway Mills Company, invented both forms of the slat attachment in "a little more than a week after their first exposure to the problem".[9] The finding is in direct conflict with the record. Short testified without contradiction that the first time Parker

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[8] The pattern mechanism built into the slats is the notches in one set of the slats which vary in depth in accordance with the pattern.

[9] The "problem" was the construction of a device which would provide independent control of the individual pile yarns fed to the needles of a tufting machine.

and Short were exposed to the problem was late in 1953; their solution was an attachment wholly unlike the slat attachment and so impractical that it was discarded. In June, 1955, about 18 months after their "first exposure to the problem", they again attempted to obtain independent control of individual yarns being supplied to tufting machine needles and, this time after several days of thought, Parker devised and Short constructed a slat attachment (App. C pp. 38a-39a).

The third finding, No. 15 (App. B p. 24a), relied on by the trial court as a basis for the conclusion of invalidity, is that four different persons invented slat attachments "as soon as the desire to make them manifested itself" and that this is a "well-nigh conclusive demonstration" that to make an attachment is obvious. The finding is in direct conflict with the record. The four persons referred to are Odenweller, Crawford, Parker and Short, considered to be one person, and Williams.[10] The undisputed testimony is that, on their first attempt to solve the problem of independently controlling individual pile yarns in a tufting operation, Odenweller and Crawford both failed and did not conceive a slat attachment until months later (App. C p. 37a). Parker and Short failed on their first attempt and did not succeed until their second attempt, a year and a half later (App. C p. 38a). Williams understood the problem in 1950 and worked on it for years, but he did not hit upon the slat attachment until 1957 or 1958 (App. C p. 39a).

The trial court's Conclusion No. 5 that infringement was not proved (App. B p. 32a) is based on Finding No. 25 (App. B p. 30a) that the claims sued on are restricted to an attachment operated in synchronism with the needles of the tufting machine, that is, with the drum or chains

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[10] The opinion copied from a trial brief refers to three persons, namely, Odenweller, Crawford, and Parker and Short (App. B p. 7a).

advancing at such a rate that a wave of yarn gripped between intermeshing slats is released for each down stroke of the needles. The finding is that both patents require synchronized operation, the patent specifications emphasize synchronization of machine and attachment as essential, and petitioner's witnesses testified at length as to the importance of synchronization.

There is not one word in either patent requiring that the patented attachment be operated in synchronism with the needles of the tufting machine with which it is used, and nothing in the history of either patent restricts the claims to synchronization. The patents describe synchronization of attachment and machine in compliance with the requirement of 35 U. S. C. 112 that the specification describe the "best mode contemplated by the inventor of carrying out his invention." Plaintiff's witness Lawrence said that synchronization is desirable but not necessary (I 358; II 529) and Crawford said the same thing (I 422-3). Respondents' witness Nix could point to no significant structural differences between respondents' slat attachments and those of the patents (II 642-3) and said that respondents might operate in synchronism or might not (II 620).

Reasons for Granting the Writ

1. The Court should grant this petition in the exercise of its supervisory authority because, in this case, the trial court has shirked its judicial duties and its derelictions have been sanctioned by the Court of Appeals. As a result, petitioner has been denied its rights and has suffered a gross injustice. The importance of the case transcends the issues involved and the rights of the litigants in that it affords the Court an unusual opportunity to correct practices of trial courts which ought to be terminated forthwith. The first of these practices has to do with opinions and the second with the fact finding process.

The trial court filed an opinion which, except for immaterial changes and omissions, was copied verbatim from respondents' pre-trial memorandum written by their counsel months before the trial began. The opinion contains many generalities and irrelevancies and is permeated with a philosophy antagonistic to the patent system and to patentees. Since the opinion was composed by an advocate before trial instead of by the trial judge after trial, it contains, as might be expected, merely a statement of what the advocate hoped to prove.

The use by the trial court for its opinion of a section of respondents' pre-trial memorandum constitutes a failure of the court to perform a judicial function of great importance to petitioner and is equivalent to having an opinion prepared by respondents' counsel without notice to petitioner. If an opinion is filed by a trial court, it ought to express the results of the judge's own independent labors, and it should be prepared only after a careful review of the evidence. The losing party is entitled to such a study of the record before a decision against him is handed down and, since an opinion is likely to be published and to be referred to in the future by both litigants and courts, a judge has a duty not to file opinions, which will not stand the closest scrutiny. In this case, the indifference of the court to the rights of petitioner is particularly flagrant because the opinion was not even based on evidence brought out at the trial. It has been held that there is no authority in the Federal Courts countenancing the preparation of an opinion by counsel for the winning party and that such action amounts to a denial of due process.[11] Fortunately, the practice of filing opinions written by counsel for the winning party does not seem to have spread widely among the lower Federal Courts but an overworked trial judge is likely to find it attractive. It is a practice so prejudicial

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[11] *Chicopee Mfg. Corp.* v. *Kendall Co.*, 288 F. 2d 719, 724 (4 Cir. 1961), cert. den., 368 U. S. 825 (1961).

to the rights of appellants that it ought to be stopped by this Court before it can spread further.

The second practice, which occurred in this case and which this Court should correct, is the mechanical adoption by the trial court of findings of fact prepared by counsel for the winning party. Although this practice has been condemned by most of the Courts of Appeals, and commentators[12] have inveighed against it, trial courts continue to follow it.

The requirement of Rule 52(a), F. R. C. P., is that, in "all actions tried upon the facts without a jury . . ., the court shall find the facts specially" and this rule is one of the most important safeguards of the rights of litigants in our judicial system. The requirement is intended to assist the appellate courts in the performance of their duties but its more important purpose is to attempt to insure that the trial court will exercise due care in ascertaining the facts and will make correct findings. Every judge preparing findings and every lawyer writing a brief know that what seems to be a clear recollection of testimony is frequently found incorrect when the recollection is to be put into words and the record is examined in that connection. The importance of correct fact finding to the defeated party in the trial court can hardly be exaggerated because the Rule provides that findings "shall not be set aside unless clearly erroneous", whereas an appellant is under no corresponding burden in seeking the correction of an error in the application of a rule of law. The acceptance of findings prepared by winning counsel inevitably leads to grave abuses in that counsel will naturally put his case as strongly as possible in such findings so that they are likely, as in the present case, to contain arguments, slanted statements, and half-truths, and to suffer from omissions. The trial court is then tempted to rely on his

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[12] Otis "Improvement in Statement of Findings of Fact and Conclusions of Law", 1 F. R. D. 83, 85; *U. S.* v. *El Paso Natural Gas Co.*, 376 U. S. 651, 656n (1964).

memory and may adopt such findings mechanically, as was done here, and without checking the record for support for them.

Appellate courts have said that findings prepared by counsel are "unfortunate and undesirable"[13] and less helpful than those resulting from "the independent judicial labors and study of the district judge".[14] Such findings have also been characterized as not "entitled to the same weight and dignity which they would have possessed had they represented the unfettered and independent judgment of the trial judge."[15] Despite the strictures placed by reviewing courts upon findings prepared by counsel, those courts grudgingly accept such findings, if supported by evidence. What the courts overlook is that the preparation of findings by winning counsel deprives the losing party of an important right, namely, the assurance that the findings represent the views of the trial court based on a review of the evidence. Moreover, the practice increases the chance of error by the trial court with a resultant increase in appellant's burden of showing that the findings are clearly erroneous.

In this case, petitioner has never had the benefit of the independent thought and judgment of the trial court. There is not a single statement of significance in the opinion or in the findings of fact and conclusions of law expressive of thoughts of the trial court, and the adoption by the court of findings which could so easily have been found to be in conflict with the record, as pointed out above, is strong proof that the court did not examine the record, despite any statements to the contrary.

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[13] *City of New York* v. *McLain Lines*, 147 F. 2d 393 (2 Cir. 1945).

[14] *Kinnear-Weed Corp.* v. *Humble Oil and Refining Co.*, 259 F. 2d 398, 401 (5 Cir. 1958), cert. den., 361 U. S. 903 (1959).

[15] *The Severance*, 152 F. 2d 916, 918 (4 Cir. 1945), cert. den., 328 U. S. 853 (1946).

The Court of Appeals merely expressed agreement "with the result reached by the trial court" (App. B p. 34a) and said (App. B p. 36a) that it considered "the opinion of the District Court . . . a correct disposition of the issues presented". Before coming to that view, the Court of Appeals may have examined the entire record but, if it did, it carefully refrained from saying so and from commenting on the evidence.

We believe that this petition should be granted not merely to give petitioner the day in court so far denied it but to afford this Court an opportunity to speak out with respect to the proper performance by trial courts of their judicial functions of writing their own opinions and preparing their own findings of fact and conclusions of law. A more shocking example than the present case of the injustice that can be done to a litigant by the failure of a trial court to carry out its duties and obligations could scarcely be found.

2. The decision of the Court of Appeals is believed to be erroneous in that the holding of invalidity is based on a misunderstanding of provisions of Sec. 103 which have not been and ought to be interpreted by this Court for the benefit of the lower courts.

Certiorari has recently been granted by this Court in five patent cases,[16] in each of which it will be necessary to consider provisions of Sec. 103. It is not likely that, in deciding these cases, there will be any occasion for a discussion of the meanings of the term "obvious" and of the phrase "the subject matter as a whole" appearing in the section. These parts of the section are vital and, if they are to be interpreted as has been done by the Court of Appeals in this case, the section will make it almost im-

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[16] *Graham* v. *John Deere Company*, No. 580, this term; *Calmar, Inc.* v. *Cook Chemical Co.*, No. 778, this term; *Colgate-Palmolive Co.* v. *Cook Chemical Co.*, No. 810, this term; *U. S.* v. *Adams*, No. 906, this term; *Hazeltine Research, Inc.* v. *Ladd*, No. 919, this term.

possible to patent any invention, regardless of its merit. This case, therefore, offers an opportunity for a pronouncement by this Court which will serve to guide the courts below in matters of great importance in patent law.

The Court of Appeals approved the finding (App. B p. 24a) of the District Court that "the fact" that four different persons were able to devise the slat pattern attachments of the patents in suit "as soon as the desire to make them manifested itself" was an almost "conclusive demonstration" that the attachments were obvious to a person having ordinary skill in the art. The record shows (App. C pp. 37a-38a) that, on their first attempt to achieve the control of individual yarns afforded by the patented attachment, three of the four persons did not at once devise a slat attachment but something entirely different which proved to be a failure. They invented the slat attachment on their second attempt, which occurred from 6 to 18 months after the first. About 6 years elapsed between the time the fourth person recognized the desirability of individual yarn control provided by a slat attachment and the time he constructed a model of a slat attachment and, in that period, he tried many things to obtain the desired effect but without success (App. C p. 39a). When the Court of Appeals says, in the face of the history of the efforts of the four persons mentioned, that the slat attachment is obvious, it is clear that the Court does not give the word "obvious" its ordinary dictionary meaning of "capable of easy perception; requiring very little insight or reflection to perceive, recognize, or comprehend",[17] instead, the court is using some meaning known only to itself. If the slat attachment, which took four persons respective periods of from six months to six years to devise, is obvious and unpatentable, then there is scarcely anything in the useful arts which is not equally obvious and unpatentable. It seems clear that the term refers to some-

[17] Webster's Third New International Dictionary (p. 1559).

thing which a person of ordinary skill, when faced with a problem, would adopt with little cogitation or delay on his first attempt to solve the problem. The undisputed testimony in the record as to the activities of the four persons shows that the slat attachment was anything but obvious.

Sec. 103 says that the differences between the patented subject matter and the prior art are to be the basis for determining whether "*the subject matter as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art . . ." (emphasis ours). Since the obviousness of the subject matter "as a whole" is the criterion of patentability, it necessarily follows that the differences between the subject matter "as a whole" and the prior art are to be determined and employed as the test of obviousness. If all such differences are not considered, the phrase is without meaning and it is impossible to reach any conclusion as to the patentability of the subject matter as a whole.

In this case, the District Court paid lip service to Sec. 103 by saying that to "evaluate invention, one must first determine just what difference or differences exist between the patentee's contribution and the prior art" (App. B p. 10a). However, when faced with the task of determining the differences between the slat attachment of the patents and furnishing wheels, the Court considered only a single structural difference and ignored other structural differences and differences in purpose, mode of operation, and results obtained. The conclusion of the court that the patents define only "an obvious use of the intermeshing principle of yarn-furnishing wheels" (App. B p. 32a) is thus unjustified in view of the Court's failure to take into account all the factors to be weighed in determining obviousness.

In accepting without comment the findings and conclusions of the District Court on the question of obviousness,

the Court of Appeals has given tacit approval to misinterpretation of Sec. 103 on two critical points, namely, the meaning and significance of the term "obvious" and of the phrase "the subject matter as a whole". As the term and the phrase are the basis of the test of patentability defined in Sec. 103, this Court should give the lower courts the benefits of its views on the points by granting certiorari in this case and correctly applying the section.

3. The decision of non-infringement in this case is erroneous and involves a complete disregard of rules of law enunciated long ago and followed ever since.

The undisputed testimony is that the slat attachment of the patents in suit may be operated in synchronism with the tufting machine, with which it is employed, or out of synchronism with the machine (*supra* p. 11). The patents describe synchronized operation in compliance with the requirement of 35 U. S. C. Sec. 112 but nothing in the patents requires synchronized operation and nothing in the proceedings leading to the grant of the patents limits their scope to synchronized operation. There can be no doubt that respondents' slat attachments are in all essential respects of the same construction as those of the patents and function in the same way to produce the same result (II 620, 643).

The Court of Appeals erred in approving the trial court's conclusion of non-infringement, in that it has been held for years that the claims of a patent rather than the specification measure the scope of the protection and that a patent is, therefore, not to be limited to what is described and illustrated in it.[18] It is likewise a fundamental rule that every patent is entitled to the benefit of the doctrine of equivalents.[19] The Court of Appeals disregarded both

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[18] The Paper Bag Patent Case, 210 U. S. 405, 418 (1908).

[19] *Miller* v. *Eagle Mfg. Co.*, 151 U. S. 186, 207 (1894); *Graver Mfg. Co.* v. *Linde Co.*, 339 U. S. 605, 607 (1950).

rules and held that infringement of a patent by a device of essentially the same construction and mode of operation as that of the patent and producing the same result is avoided by running the device at a speed different from that recommended for the patented device when speed is not critical in either case. The mere statement of the basis of the conclusion shows how obviously erroneous it is.

Finally, in considering infringement of the Odenweller patent, the District Court violated the basic rule of claim construction that a limitation must not be implied in one claim if that same limitation appears in another.[20] The claims of the Odenweller patent, of which infringement is charged, contain no language restricting them to synchronized operation, but claim 5 is so limited. It is, therefore, improper to limit the claims sued on to synchronized operation in view of the presence of that limitation in claim 5. In accepting the conclusion of the District Court, that the claims were not infringed because of their being limited to synchronized operation, the Court of Appeals has sanctioned the violation by the District Court of this long established rule.

Conclusion

We recognize that this Court is reluctant to set aside concurrent findings of fact by two courts below but the "two court" rule contains an exception and will be disregarded when manifest error is shown.[21] This case should not be subject to the rule because it comes within the exception and because of the manner in which the findings were made.

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[20] *Symington Co.* v. *National Castings Co.*, 250 U. S. 383, 385 (1919).

[21] *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 275 (1949); *Goodyear Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 278 (1944).

Undisputed testimony establishes that, of the four principal findings, on which the conclusions of invalidity and non-infringement were based, Findings Nos. 10, 15, and 25 are clearly erroneous. Finding No. 12 does not justify a conclusion that the patented "subject matter as a whole" was obvious because the finding considers a single difference between the subject matter and the prior art and disregards other and more important differences. The showing of error is "obvious and exceptional" as referred to in *Graver* and the "strong case" of *Goodyear* has been made out.

Although the District Court appears to have made findings of fact and the Court of Appeals concurred in them, the flat contradiction of the principal findings by the record makes it impossible to believe that the District Court did anything but mechanically adopt the findings prepared by respondents' counsel without reviewing the record and that the Court of Appeals likewise accepted the findings without a careful study of the record. In such a situation, concurrence in the findings is without significance and in no way adds to their weight or authority.

Certiorari should be granted, in order that this Court may put an end to the improper practices which occurred in this case, express its views as to the meaning of "obvious" and the "subject matter as a whole" as employed in Sec. 103, and give petitioner its day in court.

Respectfully submitted,

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 253

MOHASCO INDUSTRIES, INC.,

Petitioner,

vs.

E. T. BARWICK MILLS, INC.,

AND

BARWICK CARPET MILLS, INC.,

Respondents.

APPENDICES TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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